

**REMARKS**

Claims 1-13 are pending in the present application. Claim 1 has been amended to clarify that the wrap film comprises a layer of resin composition (C) as at least one "outermost" surface layer. Applicants discuss in detail below how this amendment does not enter new matter to the disclosure.

**September 1, 2005 Interview Regarding The August 24, 2005 Office Action**

Applicants are in receipt of an Office Action dated August 24, 2005 from the Examiner which appears to have been sent in error. The Examiner appears to have made a mistake and issued an Office Action which was prepared for another application, but the Examiner put a cover sheet on the Office Action having the information relating to the instant application. For example, 1) the August 24, 2005 Office Action refers to an Appeal Brief filed June 10, 2005, but no Appeal Brief was ever filed in this case; 2) the August 24, 2005 Office Action indicates that there are 8 claims pending when in fact there are 13; and 3) the August 24, 2005 Office Action cites references teaching potting compounds for potting electrical components (see the paragraph bridging pages 3-4).

On September 1, 2005, Applicants' representative, Garth M. Dahlen, Ph.D., Esq. (#43,575) attempted to contact Examiner Miggins but was unsuccessful. Dr. Dahlen then contacted the Examiner's supervisor, Mr. Pyon. Mr. Pyon indicated that it is appropriate for Applicants to file the RCE and Reply as originally planned with an explanation of the situation.

Examiner Miggins is requested to clarify this matter for the record in the next written communication.

**August 19, 2005 Interview Regarding The August 3, 2005 Advisory Action**

Applicants note with appreciation that the Examiner has conducted a telephonic interview with Applicants' representative, Garth M. Dahlen, Ph.D., Esq. (#43,575) on August 19, 2005. The Examiner was very helpful in clarifying the outstanding issues. Further details of the August 19, 2005 Interview are provided below.

**Remaining Rejections — Rejections based on Shibata et al. in view of Kuroki et al,  
optionally in view of JP '747**

In paragraph 14 of the March 1, 2005 Final Office Action, Claims 1-13 are rejected under 35 U.S.C. 103(a) being unpatentable over Shibata et al. in view of Kuroki et al., (EP 1029890A2). Also, in paragraph 10 of the March 1, 2005 Office Action, Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. and Kuroki et al. as applied to claims 1-13 above, and further in view of JP 05-162747 (based on its English abstract). These two rejections will be dealt with together because they both deal with the combination of Shibata et al in view of Kuroki et al.

Applicants respectfully traverse both rejections for the following reasons.

In the August 3, 2005 Advisory Action, Examiner Miggins maintains the argument originated with Examiner Nolan that claim 1 remains obvious in view of the transitional phrase

“comprising” which is an open-ended phrase. Examiner Miggins has taken the position that this phrase allows for layers other than the layer containing resin composition (C) as the surface layers. In order to clarify the invention, during the August 19, 2005 Interview, Dr. Dahlen proposed amending claim 1 to either recite that the layer of resin composition (C) is in an “outermost” surface layer or is in an “exposed” surface layer.

Examiner Miggins preferred the term “outermost” over the term “exposed”.

Dr. Dahlen brought to the Examiner’s attention that the term “outermost” is not explicitly described in the present specification. The Examiner took the position that he would find there to be sufficient implicit written description support in the present specification for this term “outermost” so long as one of the exemplified embodiments in the specification used the layer of resin composition (C) in the outermost surface layer. The Examiner will note that Examples 12-15 and 17 used the layer of resin composition (C) in the outermost surface layer. Accordingly, no new matter was added to the disclosure upon amending claim 1 to recite that the layer of resin composition (C) is in an “outermost” surface layer.

Next, Dr. Dahlen asked Examiner Miggins that if claim 1 were to be amended to recite the term “outermost”, would Examiner Miggins withdraw the two remaining rejections. Examiner Miggins indicated that he would withdraw the two remaining rejections<sup>1</sup>.

Applicants now essentially reiterate the patentable distinctions between the present invention and the cited references which were presented as part of the July 28, 2005 Reply, however, the discussion presented below takes into consideration the effect of the above-

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<sup>1</sup> However, Examiner Miggins was not able to tell Dr. Dahlen if such an amendment would place the application in condition for allowance, since Examiner Miggins is required to do a supplemental search for additional prior art.

amendment clarifying that a layer of resin composition (C) is in at least one "outermost" surface layer of the inventive wrap film.

The present invention is drawn to a wrap film comprising a layer of resin composition (C) as at least one "outermost" surface layer, wherein resin composition (C) comprises an aliphatic polyester resin (A) and a liquid additive (B), wherein the surface layer has a surface roughness of 0.5 to 4.0 nm, and the wrap film has favorable strength, heat resistance and cling properties. Not only is the inventive wrap film easy to use, but it comprises an aliphatic polyester which is considered biodegradable. It is this combination of properties, which makes the inventive wrap film more desirable than the wrap films in the prior art.

Shibata et al. disclose a wrap film made from a *polyolefin* and not an aliphatic polyester as claimed by Applicants. Although Shibata et al. state that a low surface roughness of a polyolefin film contributes to the enhancement of the clinging property, the level of the mentioned low roughness of Ra is of 40 to 60nm. This surface roughness of the film disclosed in Shibata et al. is about ten times higher than the film claimed in the present application. More specifically, Shibata et al. disclose a wrap film surface roughness equal to or less than 0.08  $\mu\text{m}$  (80 nm) in terms of Ra and equal to or less than 0.66  $\mu\text{m}$  (650 nm) in terms of Rz, beyond which the roughness decreases the clinging energy (see par. 0126). The examples disclose films that have Ra of 0.04 - 0.06  $\mu\text{m}$  (40 - 60 nm) and Rz of 0.4 - 0.6 nm (400 - 600 nm) (see par. 0169 and Tab. 8).

Kuroki et al. disclose a film made from an aliphatic polyester. The surface roughness of the film is not measured, however, it can be assumed that the surface roughness is a conventional surface roughness. There are no special techniques disclosed in this reference that would allow

the production of a film having an extremely low surface roughness, as claimed in the present application. **Importantly**, Kuroki et al. disclose that if special surface properties are desired, additional layers can be **placed on** the polyester film (see paragraphs [0045] –[0047]). These additional layers used for coating on the wrap film include an acrylic resin as copolymer made from acrylic ester and other vinyl monomers to impart a clinging property to the wrap film. In the sense that the coating constitutes another layer, Kuroki et al.'s aliphatic ester film cannot be exposed to have an excellent clinging property. In such a situation, the disclosed aliphatic polyester would no longer be an "outermost" surface layer formed from an aliphatic polyester having certain properties, as presently claimed. The aliphatic polyester layer that was previously a surface layer would no longer be an "outermost" surface layer after it is coated by another material. The aliphatic polyester film of the present invention has a surface with an extremely low surface roughness therefore it needs no extra additional layer for an excellent clinging property.

According to MPEP 2141, when applying 35 U.S.C. § 103, one of the tenets of patent law which must be adhered to is that the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. It is respectfully submitted that even if Shibata et al. is combined with Kuroki et al., there is no suggestion of preparing a film from an aliphatic polyester having a smoothness within the claimed range. The only cited reference that gives a smoothness value (Shibata et al.) describes a surface ten times more rough than the present invention. Kuroki et al. do not indicate that if one wants to change the surface properties of the polyester film disclosed therein, one should coat the surface of the polyester film with another layer. Even if the two references are considered in combination, there

is no suggestion of preparing a film of an aliphatic polyester having an extremely smooth surface as claimed in the present application.

It is believed that this explanation in combination with the above-amendment to claim 1, sufficiently distinguishes the present invention from the combination of Shibata et al. and Kuroki et al.

In paragraph 10 of the March 1, 2005, Examiner Nolan included JP 05-162747 (JP '747) with the teachings of Shibata et al. and Kuroki et al. to try to establish that claims 6 and 7 are obvious. In other words, JP '747 was cited for teaching paper cutters. In view of the fact that JP '747 does not fairly suggest modifying the polyolefin wrap film of Shibata et al. to have the instant surface roughness and to be made of a polyester, JP '747 does not cure the deficiencies of Kuroki et al. and Shibata et al.

Accordingly, withdrawal of the rejections based on Kuroki et al., Shibata et al. and JP '747 is respectfully requested.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.**

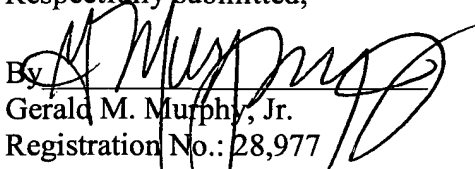
Application No. 10/622,571  
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First Preliminary Amendment

Docket No.: 0071-0528P

(Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

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